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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/740,065
Filing Date: December 20, 2000
Appellant(s): GERSHFELD, JACK

Vladimir Khiterer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/28/2006 and the Correction to Amended Brief on Appeal filed 8/6/2007, appealing from the Office action mailed 6/29/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the Correction to Amended Brief is substantially correct. On page 2 of the Correction to Amended Brief, Appellant explains, "The output of the Video Synchronizer 70 is applied to Video Display 40, such that full images of the degraded and reference video signals (50a and 60a) are displayed simultaneously on different portions of the video display". However, neither the specification, nor original claims, mentions the term, "full images".

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4,257,066

Kaneko

3-1981

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 2623

Amended claim 1 includes the feature "full image", which is not found in applicant's invention. Thus the scope of "full image" is not defined. It is unclear whether "full image" means that the image has not been reduced, i.e., displayed at 100% on the display screen, (which would apparently preclude both images from being displayed simultaneously) or that the image is reduced so that it fits on only a portion of the screen, (which allows both of the images to be displayed simultaneously) but that the whole portion of the image is displayed, for instance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1 is rejected as being unpatentable over Kaneko, (U.S. Pat # 4,257,066).

Considering claim 1, the amended claimed method of evaluating degradation of an electrical signal caused by a circuit comprising:

Art Unit: 2623

‘placing a first video signal in communication with a communication circuit, passing the first video signal through the circuit’, reads on a video program being broadcast, as taught by Kaneko using cable or over the air broadcasts, see col. 2, lines 46-50.

‘providing a means of synchronizing and combining electrical signals having a first and second input and at least one output is met by the operation of Kaneko, which receives up to two video inputs and outputs the synchronized video for display on a TV screen, Abstract, col. 1, lines 45-55; col. 6, lines 54-64 & col. 9, lines 5-20.

‘placing a second video signal identical to the first video signal, in communication with the second input of the means of synchronizing and combining’, reads on the disclosure in Kaneko that one of the inputs to the monitor circuits 11, may be from a VCR tape, col. 7, lines 1-10 & col. 8, lines 54-60. However, Kaneko does not state that the content of the VCR is the same as the first video signal, even though the invention is directed to comparing these two signals. Nevertheless, as for the content of the tape, such a feature falls within the scope of ‘intended use’. In other words, the content of the tape may be the same content as the video program being broadcast and received via antenna 31.

Thus, Official Notice is taken that at the time the invention was made, it was known to store video programming on a VCR tape that could also be broadcast. It would have been obvious for one of ordinary skill in the art at the time the invention was made, to operate Kaneko in a manner that the content on the tape is the same as the content being received at antenna 31,

Art Unit: 2623

since Kaneko is directed to comparing the two video sources in a side-by-side fashion, see Abstract & col. 1, lines 39-42.

‘placing the output of the synchronizing and combining means in communication with a video display such that full images and reference video signals are displayed simultaneously on different portions of the screen’, reads on the signals being fed to the monitor circuits 11 and TV screen 12, col. 9, lines 1-10. The claimed feature is met by whole images that are displayed only on portions of the screen and not the whole screen, such as a split screen. Therefore, if the disclosure of applicant’s specification is a ‘full image’, i.e., a ‘whole image’, then the disclosure in Kaneko also reads on the claimed ‘full image’.

‘presenting the two video signals separate from each other’ and ‘comparing the full images in order to assess the degradation of the reference video signal is met by the disclosure of Kaneko, col. 1, lines 35-60; col. 2, lines 35-60 & col. 9, lines 1-25, which is directed to presenting two video signals together in a TV screen for the purpose of comparison.

(10) Response to Argument

Regarding the 112, 1st paragraph rejection, appellant’s argues on pages 3-6 of the Brief that ‘full image’ is intended to be construed as an image on a portion of the screen, not the full screen. Examiner points out that there is no disclosure in the specification that limits the “image” to be for instance the triangle shown in the drawings. To the contrary, the “image”

Art Unit: 2623

shown may include any background or surrounding in a video or still image scene. For example, in a scene showing an automobile parked on the street, there is no disclosure that the "image" is limited to the automobile and not any surroundings images that may be included in the scene. Likewise, there is no disclosure that only the triangle is transmitted and not the white background that is also shown in Fig. 1 of the drawings. This discussion is relevant, since appellant's specification is directed to transmission of video signals, and does not disclose that the invention is directed to only the transmission of, for instance a test image such as a geometric figure for comparison. To the contrary, the specification at numerous instances refers to video signals that are transmitted, not still or graphic images, see page 7, for example.

Examiner points out that appellant uses the terms, 'without being split, clipped or broken in parts' to describe 'full image' in the Appeal Brief, but these terms do not appear in original specification. Appellant asserts that an identical (scaled) representation of a transmitted image, is compared with an image displayed on the video signal, see page 4. However, it is not totally clear that the triangles shown in section 50a is exactly proportional to the original triangle, prior to transmission.

Furthermore, in light of the above discussion, that the specification does not limit the image to the triangle, it appears that Fig. 2 shows that not the entire original white background is transmitted. In other words, the white background appears to have been clipped, since proportionally, there appears to be more space on the sides of the triangle in Fig. 1, than in 50a of Fig. 2. Also, proportionally there is more space on the top and bottom of triangles in Fig. 2, than

Art Unit: 2623

the triangle in Fig. 1. This observation is relevant since the screen that the image is shown in Fig. 1, is clearly not the same proportional dimensions of the either of the two half screens shown in Fig. 2.

Appellant also asserts on page 5, "it would have been obvious to one of ordinary skill in the art, from reviewing the original specification and drawings, that the term "full image" describes an image that has not being split, clipped or otherwise broken in parts, yet an image that can be scaled to fit on a certain portion of the screen without being split, clipped or broken". First of all, it is pointed out that the obviousness test does not apply to whether or not a claimed feature has direct support in the specification. Secondly, as pointed out in the previous Office Action, the term "full image" may be construed to mean "not reduced", which cannot be supported by appellant's specification. This discussion is the reason why obviousness cannot be the test for support, since it would also have obvious for "full image" to also mean "not reduced". All claimed features must be clearly supported by the specification, or inherent.

Appellant's main argument (a) regarding the prior art rejection, is that Kaneko does not display two images simultaneously 100 % of time, as is done by the present invention.

Examiner first of all points out that on page 7 of the brief, appellant notes that Kaneko is functionally equivalent to the present invention. **In particular, appellant states that the "similarity between the present invention and Kaneko is that the viewer can see images from two sources displayed on different portions of a screen (i.e., side by side or top and**

Art Unit: 2623

bottom) for comparison". Thus, not only does appellant concede that Kaneko teaches the claimed, feature of:

'(e) placing the output of synchronizing and combining video signals in communication with a video display such that images are displayed on different portions of the video display', but appellant also confirms that Kaneko operates with the same purpose as the present invention, i.e., 'for comparison' of 2 images.

Appellant however argues on pages 7-8, that even though Kaneko teaches simultaneously displaying the images, the images are not simultaneously displayed 100% of the time. It is argued that because Kaneko employs a changeover switch 36, the viewer only sees half of the image from the output 35A and half of the image from output 35B. On page 6, appellant cites a portion of claim 1, col. 9, lines 45-53, directed to a "switch means having a control input receiving control signal for selectively applying one of said first and second video signals...". Examiner finds no support for appellant assertion that the viewer in Kaneko only sees the images half of the time. In fact, since Kaneko states the images are simultaneously displayed, it is clear the images are simultaneously at the same time. Examiner asserts that simultaneous display was a term of art, well understood at the time the invention was made, in the field of split screen and PIP TV systems, to mean that the two images are displayed at the same time.

Notwithstanding appellant's argument, the simultaneous display in Kaneko allows the viewer to view the two images at the same time, without having the images displayed in a

Art Unit: 2623

staggered arrangement, which Kaneko teaches is an advantage, see Abstract; col. 1, lines 15-42. Therefore, regardless of whether Kaneko achieves simultaneous display by switching between the two inputs, these mechanical workings of the receiver circuitry are of no concern of the viewer, as long as the viewer perceives the two images to be displayed simultaneously.

Examiner points out that the claim merely requires that the two video signals are simultaneously displayed, which is clearly met by Kaneko and does not require 100% of the time. Furthermore, it is pointed out that Kaneko explicitly states that the invention simultaneously displays signals A & B, which reads on the claimed 'simultaneous', col. 1, lines 35-64 & col. 6, lines 54-64.

Appellants second argument (b) is that the present invention can be used to assess degradation of video signals of circuits having virtually unlimited distance, which cannot be done by utilizing Kaneko. Examiner points out that such a limitation is not found in the claims. The claims do not recite any characterization of the 'circuit' with respect to its length, or the distance between the first video signal and video display. Thus, Kaneko still reads on the claimed language, of 'passing the first video signal through a circuit thereby causing the circuit to output a degraded video signal'. Moreover, in the rejection, examiner asserts that 'circuit' is met by the broadcast medium in Kaneko.

As for the Official Notice taken, that at the time the invention was, it was known to store video programming on a VCR that could be broadcast, examiner supplies a reference to support

Art Unit: 2623

the assertion. First of all, it is pointed out that Official Notice was taken because even though Kaneko teaches that content stored on a VCR local to a user, may be compared with content broadcast and received by the user terminal, Kaneko does not explicitly state that the content of both sources may be the same, i.e. identical images. The reference supplied by examiner is Banker, which teaches that the NVOD system is equivalent to renting a movie stored on a video tape. Thus, Banker (5,357,276) provides evidence that the same movie that may be stored on a video taped and played back on a VCR, can be broadcast to a customer. The combination of Kaneko & Banker would teach one of ordinary skill in the art, to compare the quality of the content stored on a VCR tape, such as a movie, with the quality of the content of the same movie that has been broadcast, col. 2, lines 10-26.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Art Unit: 2623

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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